

## REMARKS

Claims 1 through 38 are pending in this Application, of which claims 17 through 38 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Accordingly, claims 1 through 16 are active.

In response to the fourth enumerated paragraph on page 6 of the July 5, 2005 Office Action, Applicants affirm the election of claims 1 through 16.

**Claims 1 through 4 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Glatkowski et al.**

In the statement of the rejection the Examiner asserted that Glatkowski et al. disclose a nanocomposite dielectric comprising a plurality of carbon nanotubes dispersed in a polymer matrix and a metal coating on the dielectric. Somehow the Examiner interpreted claims 1 and 2 to encompass such a structure. This rejection is traversed as factually and legally erroneous.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). When imposing a rejection under 35 U.S.C. § 102 the Examiner is required to specifically identify where in an applied reference identically discloses each and every feature of a claimed invention, particularly where such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re Yates*, 663 F.2d 1054, 211

*USPQ 1149 (CCPA 1981); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).* That burden has not been discharged. Indeed, there is a significant structural difference between the claimed bonded structures and the structure disclosed by Glatkowski et al. that scotch the factual determination that Glatkowski et al. disclose a bonded structure **identically** corresponding to those claimed.

The claimed bonded structures comprise a carbon nanotube-based structure and a polymer (claim 2) or polymer layer (claim 1) wound around a rounded surface of the carbon nanotube-based structure. A second structure is bonded with the carbon nanotube-based structure. No such bonded structure is disclosed or suggested by Glatkowski et al.

Initially, Applicants would stress that claims must be interpreted in light of and consistent with the written description of the specification through the eyes of one having ordinary skill in the art, in the **context** of the disclosed invention. *Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc); Dayco Products, Inc. v. Total Containment, Inc., 258 F.3d 1317, 59 USPQ2d 1489 (F.C. 2001); In re Cortright, 165 F.3d 1353, 49 USPQ2d 1464 (Fed. Cir. 1999); In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997).* It is inconceivable that one having ordinary skill in the art would have construed the claimed structures to encompass the structure disclosed by Glatkowski et al. This is because it should be apparent from Fig. 1 of Glatkowski et al., that the disclosed structure comprises a plurality of CNTs dispersed in a polymer matrix. This is quite **different** from a polymer or polymer layer **wrapped around** each individual CNT, which is bonded with another structure. It is simply inconceivable that one having ordinary skill in the art would have interpreted the claimed structures illustrated, for example, in Figs. 1A-1D as described in the written description of the specification, to

encompass the embedded CNTs of Glatkowski et al. Indeed, any such interpretation is unreasonable and inconsistent with the written description of the specification.

Glatkowski et al. neither disclose nor suggest the claimed invention. Applicants submit that one having ordinary skill in the art, armed with Glatkowski et al. disclosing disbursed CNTs in a polymer matrix, would not have been motivated to arrive at the claimed structures which comprise a polymer wrapped around or wound around the CNTs. The Examiner's interpretation that a polymer layer wraps or is wound around each of the plurality of CNTs disbursed in a polymer matrix has no basis in fact or scientific logic. Moreover, even with this strained unreasonable interpretation, the metal layer disclosed by Glatkowski et al. is not directly bonded with any polymer layer, particularly since the polymer layer is not wrapped around or wound around a CNT. Clearly, Glatkowski et al. do not place the claimed invention into the recognized possession of the public. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 167 (Fed. Cir. 1994).

The above argued differences between the claimed bonded structures and the structure of Glatkowski et al. undermine the factual determination that Glatkowski et al. disclose a bonded structure identically corresponding identically to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 4 under 35 U.S.C. § 102 for lack of novelty as evidenced by Glatkowski et al. is not factually viable and, hence, solicit withdrawal thereof.

**Claims 5 through 16 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Glatkowski et al. in view of Clarke.**

This rejection is traversed. Specifically, claims 5 through 16 depend from either independent claim 1 or independent claim 2. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 2 under 35 U.S.C. § 102 for lack of novelty as evidenced by Glatkowski et al. The secondary reference to Clarke does not cure the previously argued shortcomings of Glatkowski et al. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

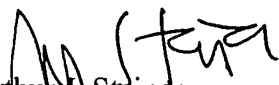
Applicants, therefore, submit that the imposed rejection of claim 5 through 16 under 35 U.S.C. § 103 for obviousness predicated upon Glatkowski et al. in view of Clarke is not factually or legally viable and, hence, solicit withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

**Application No.: 10/751,524**

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

  
Arthur J. Steiner  
Registration No. 26,106

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 AJS:bjs:ntb  
Facsimile: 202.756.8087  
**Date: October 27, 2005**

**Please recognize our Customer No. 20277  
as our correspondence address.**